

REMARKS

By this amendment claims 1-17 have been amended and claims 18-20 have been added. No claims have been cancelled. Accordingly, claims 1-20 are now pending in the application. The specification has also been amended. Reconsideration and allowance of all of the claims are respectfully requested in view of the foregoing amendments and the following remarks.

Regarding Office Action Paragraph 1 – Objection to the Specification

Paragraph 25 has been amended to add the following, in order to provide a description of an "ATV-type tire": "The front wheels define a front axis and the rear wheels define a rear axis, and each of the wheels includes an ATV-type tire, i.e. a low-pressure balloon tire having an air pressure of less than 1 kg/cm²."

It is believed that this description is already present in the application, as the vehicle described therein is an ATV, it is shown in the drawings have ATV-type tires, and this definition is known by a person skilled in the art of ATVs. For example see enclosed U.S. Patent 4,860,850, assigned to the present assignee's competitor Honda, wherein, at col. 3, lines 57-60 it states: "The wheels Wf, Wlr, Wrr each has a wide extremely low pressure tire T, for example, so-called balloon tire whose air pressure is less than 1 kg/cm², mounted thereon."

Reconsideration and withdrawal of the objection is respectfully requested.

Regarding Office Action Paragraph 2 and 3 – Rejection under 35 U.S.C. 112

Claim 1, 4 and 12 are rejected under 35 U.S.C. 112 2nd para. as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.

Firstly, the Examiner believes that the expression "an ATV-type tire" is unclear. In response, the claims have been amended to recite simply "a tire". It is believed that this amendment overcomes the Examiner's rejection in this regard.

Secondly, the Examiner believes that the claim language "in use, a combined center of gravity of the ATV, with the driver sitting a standard riding position on the main seat portion and the passenger sitting in a standard position on the secondary seat portion, is disposed in front of the rear axis..." is unclear. In response, the claims have been amended to recite, for example, "wherein the ATV is constructed and arranged such that when the standard driver is in a standard driver position defined as the standard driver straddling and being seated on the seat on the main seat portion with its feet disposed on the driver's footrests and its hands disposed on the handlebars, and the standard passenger is in a standard passenger position defined as the standard passenger straddling and being seated on the seat on the secondary seat portion with its feet disposed on the passenger's footrests and its hands disposed on the grab handles, with the ATV being steered straight forward on level ground and being in running condition, full of fuel and oil...". It is believed that this amendment overcomes the Examiner's rejection in this regard.

Reconsideration and withdrawal of this rejection is respectfully requested.

Regarding Office Action Paragraphs 4 – 35 U.S.C. 101

Examiner has rejected claims 1 and 4 under 35 USC 101 because the claimed invention is directed to non-statutory subject matter. Specifically because “the passenger is non-statutory subject matter”.

35 USC 101 states “Whoever invents or discovers any new and useful process, machine, manufacture or composition of matters, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.” In the decision of the United States Supreme Court in *Diamond v. Chakrabarty*, 447 U.S. 303, 206 USPQ 193 (1980) the Court stated that a “naturally occurring manufacture or composition of matter – a product of human ingenuity – having a distinctive name, character [and] use” is patentable.

With respect, the Examiner has misunderstood what is being claimed. Applicants are claiming an all-terrain vehicle. There can be no question that an all-terrain vehicle meets the definition set forth by the Court and is therefore patentable subject matter. Applicants do not seek exclusivity on a “passenger” or any other actual person. Applicants are only claiming an all-terrain vehicle relative to a standard passenger construct. The standard driver/passenger as used herein is a design tool – a ruler in a sense – that represents a series of measurements used in positioning the components of the vehicle. These measurements are set forth in the specification. The confusion seems to lie in the fact that the measurements are based, at least in part, on an average human body because the vehicle must be designed to accommodate a human rider to operate. The standard rider/passenger is a tool for use in designing the vehicle, as would be readily understood by one of ordinary skill in the art of designing ATVs. Such tools are typically used in computer assisted design, as is conventionally known and practiced.

In simpler terms, the standard passenger and the standard passenger position (as well as the standard driver and standard driver position) are part of the metrics by which an all-terrain vehicle will be judged to determine whether or not it is with the scope of the claims, they are not being claimed themselves. The situation is analogous to Applicants claiming an all-terrain vehicle having a certain length (e.g. 250 cm). In this situation it should be clear that is the all-terrain vehicle that is being claimed, not the Metric System of measurement, nor the device (e.g. a tape measure) by which one would do the measuring. It is clear that the present claims are directed to statutory subject matter and comply with 35 USC 101.

Regarding Office Action Paragraph 5 and 6 – Rejection under 35 U.S.C. 103(a)

Examiner is rejecting claims 1-17 under 35 USC 103(a) as being unpatentable over Kitao et al. (US Pat. No. 6,296,163). Applicants respectfully disagree.

Examiner states “Kitao, et al. teaches... a secondary seat portion, rearward of the main seat portion...” Examiner, however, is incorrect in her understanding of Kitao. Kitao is directed to a “Carrier for Straddle Four Wheeled All-Terrain Vehicle and Support Structure Therefore” (title). The ATV described therein is a standard single-seater ATV. Such ATVs have existed in the prior art for some time. The only disclosure therein regarding the seat is “seat (10)”.

A more detailed description of Kitao is unnecessary. It is clear that Kitao does not disclose “a straddle-type seat supported by the frame including a main seat portion which is dimensioned to support a standard driver having the dimension and weight of a 50-percentile human male and a secondary seat portion, rearward of and adjacent to the main portion,

which is dimensioned to support a standard passenger having the dimensions and weight of a 50-percentile human male", as is recited in all of the claims of the present application. If the Examiner believes that Applicants' characterization of Kitao is incorrect, Applicants request that the Examiner identify particular passages of text of Kitao that support the Examiner's contention.

Examiner then goes on to state: "With respect to the wheelbase, it would have been obvious design choice to have the wheelbase a specific size, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art." With respect, this is incorrect in the present situation as two-seater ATVs did not previously exist prior to the present invention thereof by the Applicants. Since two-seater ATVs did not exist, the wheelbases thereof did not exist either. It cannot therefore be possible for the recitation of the wheelbase in the current claims to be "a mere change in the size of a component", when the component did not heretofore exist.

The Examiner then goes on to state: "[w]ith respect to the straddle-type seat, it would have been an obvious matter of design choice to have the seat arranged such that the center of gravity is in the front of the rear axis by a specific distance and/or rearwardly of the front axis by a specific distance, since it is been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. With respect to the distance between the front axis and the rear axis, it would have been an obvious design choice to have a ratio of a distance between the front axis and the center of gravity to a distance between the center of gravity and the rear axis a specific value, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art."

With respect, the Examiner is incorrectly applying the law based on her incorrect understanding of the facts. As has been stated, two-seater ATVs did not exist prior to the invention thereof by the Applicants. Therefore it is not possible that "the general conditions of claim are disclosed in the prior art" since the claims are all limited to two-seater ATVs. Thus the discovery of the optimum or workable ranges of the variable set forth in the claims cannot involve only routine skill in the art in the present case.

Furthermore, even if this were not the case, the Examiner's statement of the law is incomplete. See MPEP 2144.05 II B. The complete statement is that "A particular parameter must first be recognized as a result-effective variable, i.e. a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation. *In re Antonie*, 559 F.2d 618, 195 USPD 6 (CCPA 1977)".

Applying the correct legal test to the present case, as two-seater ATVs did not previously exist, it is not possible that the particular parameter (being the relationship of the center of gravity thereof to the front and/or the rear wheel axle and/or the ratio thereof on a two-seater ATV) could have been recognized in prior art as a result-effective variable. For this reason as well then it cannot therefore be said that the recitation of these variables in the present claims is simply the determination of the optimum or workable range thereof which could be characterized as routine experimentation.

Reconsideration and withdrawal of the rejection is respectfully requested.

Conclusion

In view of the above amendments and remarks, the Applicant respectfully submits that all of the currently pending claims are allowable, and that the entire application is in condition for allowance.

Should the Examiner believe that anything further is desirable to place the application in better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,



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